

418 Rec'd PTO 05 APR 1999

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

UWE WITT ET AL.

Serial No.: 08/793,966

Filed: March 10, 1997

For: BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF

Attorney Docket No.: BOET 0103 PUSA

Group Art Unit:

Examiner:

#9

RECEIVED

05 MAY 1999

Legal Staff  
International Division

**COMBINED PETITION FOR REVIVAL OF AN APPLICATION  
FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 C.F.R. 1.137(a)  
AND SHOWING RELATED THERETO UNDER 37 C.F.R. 1.137(a)(3)**

Box DAC  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants hereby petition for revival of the above-identified application which was unavoidably abandoned. The Petition fee (37 C.F.R. § 1.17(l)) accompanies this Petition. Applicants showing is set forth below. Applicants have submitted this Petition under 37 C.F.R. § 1.137(a), but believe that it could have been presented as a request for reinstatement of an application erroneously abandoned by the Office. The facts are set forth below.

1. On September 14, 1998, Applicants requested to be informed of the status of US Patent application serial number PCT/EP95/02722. On November 19, 1998, Applicants received a letter from the PCT legal office indicating that this application had been abandoned, and that a NOTIFICATION OF ABANDONMENT had been mailed on January 2, 1998.

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Box DAC, Assistant Commissioner for Patents, Washington, D.C. 20231 on:

April 1, 1999  
Date of Deposit

William G. Conger  
Name of Person Signing

  
Signature

2. This application was filed with a defective Declaration which did not properly identify the citizenship of the inventors. The Declaration was however signed by all inventors. A notice to file missing parts was issued on April 16, 1997, giving a one month period to reply, extendable under 37 C.F.R. § 1.136(a) for a period of up to five months. On 15 May, 1997, within the one month period, Applicants submitted the Declaration signed by two of the three inventors. The third inventor had meanwhile left the employ~~ee~~ of the assignee. This second Declaration properly indicated the citizenship of all of the inventors. On June 25, 1997, a notification of a defective response was submitted by the PCT legal office. This notification of defective response indicated that applicant is required to complete the response within a time of one month or five months from the date of response set in the Notification of Missing Requirements. This latter date would have been October 16, 1997.

3. Applicants' attorney believed that the two Declarations together fully satisfied the requirements of 37 C.F.R. § 1.497 and 37 C.F.R. § 1.63, and filed a response directing the office's attention to M.P.E.P. § 602.02 which indicated that:

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but the two taken together give all the required data, no further oath or declaration is needed.

The two Declarations together did indeed give all the required data. Applicants submitted this response to the Patent and Trademark office on July 8, 1997, again well within the one month period of response required by the Notification of a Defective Response, and also within the five month period from the initial notice, which period would expire on October 16, 1997. Applicants received no further communication from the office until they received a letter dated 17 November, 1998 in response to Applicants' Request for Status of the Application, indicating that the application had been abandoned.

4. Applicants' attorney telephoned the PCT legal office and requested a copy of the Notice of Abandonment, which had never been received. Subsequently, a copy of a Notice of Abandonment was received which, however, failed to identify the application. Notably, the serial number was wrong, the first named Applicant was wrong, and the address

in Florina, Greece was totally wrong. Applicants are unfamiliar with any of the individuals, with the serial number, or the address identified in this Notification of Abandonment. Applicants never received the Abandonment.

5. Applicants believed that their response filed on July 8, 1997 was a satisfactory response in every respect to the Notification of Defective Response mailed June 25, 1997 and if not totally satisfactory, was at least a bona fide effort to respond. At the very least, Applicants believe that the Office has a duty to inform Applicants when a response is not sufficient.

6. The Manual of Patent Examining Procedure, in Section 714.05, states:

Actions by applicant, especially those filed near the end of the period for response, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, application should be notified of the deficiencies and warned to complete the response within the period.

The Patent Statutes, 35 U.S.C. § 132, indicates that "whenever, on Examination, a claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof . . . ."

7. Applicants believed that their response was completely adequate to resolve the issue of the defective Declaration. If not, Applicants would have expected to receive further notification that their response was insufficient. In keeping with M.P.E.P. § 714.05, sufficient time still remained for Applicants to reply if their response were held insufficient. Factually, more than 3 months of the entered period remained. However, Applicants could not be aware that their response was insufficient without being notified of any alleged insufficiency. This, the office never did. Moreover, the Office never informed Applicants of the abandonment of their application. Applicants never received any indication that their prior response was defective and that therefore the period for response was continuing to run. Had the office indicated that the July 8, 1997 response of Applicants was


defective in any way, Applicants would have still had time to respond by submitting an Extension of Time extending the time period well into October. Because Applicants never received any notification that this time period was running, and because Applicants never received any indication that the case was abandoned, Applicants submit that the abandonment was unavoidable.

While Applicants believe that their prior response and the two Declarations previously submitted both a bonafide attempt to respond as well as a sufficient response under the law, submitted herewith is a Declaration signed by all three inventors which without question meets all of the statutory requirements.

A check in the amount of \$55.00 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

UWE WITT ET AL.

By 

William G. Conger

Reg. No. 31,209

Attorney for Applicant

Date: April 1, 1999

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# DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

Atty. Docket No. BOET 0103 PUSA  
 First Named Inventor Uwe Witt et al.

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

## BIOLOGICALLY DEGRADABLE POLYESTER AND WORKING MATERIAL CONSISTING THEREOF

the specification of which:

- ☐ is attached hereto; or  
☒ was filed on (MM/DD/YYYY) March 10, 1997 as U.S. Application Number or PCT International Application Number PCT/EP95/02722, and was amended on (MM/DD/YYYY) \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below, and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Priority Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached? (Yes/No)
44 32 161.9	Germany	September 9, 1994		No
(1) 95 08 737.2	Germany	March 10, 1995		No

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of this application.

Application Number(s)	Filing Date (MM/DD/YYYY)	Status: Patented, Pending, Abandoned



**Declaration for Patent Application (cont'd.)**Atty. Docket No. BOET 0103 PUSA

I hereby appoint the following registered practitioners to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Ernie L. Brooks, Reg. No. 26,260; James A. Kushman, Reg. No. 25,634; David R. Syrowik, Reg. No. 27,956; Mark A. Cantor, Reg. No. 30,614; Ralph M. Burton, Reg. No. 17,748; Robert C.J. Tuttle, Reg. No. 27,962; Earl J. LaFontaine, Reg. No. 30,766; Ronald M. Nabozny, Reg. No. 28,648; Thomas A. Lewry, Reg. No. 30,770; John E. Nemazi, Reg. No. 30,876; Kevin J. Heintz, Reg. No. 29,805; William G. Abbatt, Reg. No. 31,936; Donald J. Harrington, Reg. No. 17,427; Paul M. Schwartz, Reg. No. 33,278; Timothy G. Newman, Reg. No. 34,228; Frederick M. Ritchie, Reg. No. 18,669; Robert C. Brandenburg, Reg. No. 29,048; A. Frank Duke, Reg. No. 20,937; John M. Halan, Reg. No. 35,534; Jeffrey M. Szuma, Reg. No. 35,700; James R. Ignatowski, Reg. No. 26,741; Frank A. Angileri, Reg. No. 36,733; William G. Conger, Reg. No. 31,209; Rhonda L. McCoy-Pfau, Reg. No. 37,887; Sangeeta G. Shah, Reg. No. 38,614; Christopher W. Quinn, Reg. No. 38,274; Robert C. Jones, Reg. No. 35,209; David S. Bir, Reg. No. 38,383; Konstantine J. Diamond, Reg. No. 39,657; James N. Kallis, Reg. No. 41,102; Hugo A. Delevie, Reg. No. 32,688; Ralph E. Smith, Reg. No. 35,474; Michael S. Brodbine, Reg. No. 38,392; Jeremy J. Curcuri, Reg. No. 42,454; Mark D. Chuey, Reg. No. 42,415; and John J. Ignatowski, Reg. No. 36,555; Pete N. Kioussis, Reg. No. 41,117; Gigette M. Bejin, Reg. No. P-44,027; Stephanie M. Mansfield, Reg. No. P-43,773; Mark E. Stuenkel, Reg. No. P-44,364.

Address all correspondence and telephone calls to William G. Conger  
at Brooks & Kushman P.C., 1000 Town Center, Twenty-Second Floor, Southfield, Michigan 48075, (248) 358-4400.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**Full Name of Sole or First Inventor** Uwe WittInventor's signature X [Signature] Date 19/1.99Post Office Address Same As Residence AddressResidence Mascheroder Weg 1, 38124 Braunschweig, Germany Citizenship German**Full Name of Second Joint Inventor** Rolf-Joachim MuellerInventor's signature X [Signature] Date 28.01.99Post Office Address Same As Residence AddressResidence Mascheroder Weg 1, 38124 Braunschweig, Germany Citizenship German**Full Name of Third Joint Inventor** Wolf-Dieter DeckwerInventor's signature X [Signature] Date 14/1.99Post Office Address Same As Residence AddressResidence Mascheroder Weg 1, 28124 Braunschweig, Germany Citizenship German